

II. Claim Rejections -- 35 U.S.C. § 103(a)

A. Claims 1, 5, 10, 11, 22, and 23

Claim 1 recites a unique combination of features including, *inter alia*, "selecting a string of character information in a window displayed by the operating system, and storing the selected string of character information" (*see also* claims 5, 10, 11, 22 and 23). The Examiner alleges that Bayless teaches these features at col. 15, line 62 to col. 16, line 3 and col. 22, lines 35-43. Applicant respectfully disagrees.

Bayless describes the manual entry of telephone digits by a user into a directory of a computer telephone system (Bayless: col. 22, lines 35-43; Fig. 25). The manual entry of telephone digits by a user does not correspond to "selecting a string of character information in a window displayed by the operating system" (*see* claims 1, 5, 10, 11, 22 and 23).

Furthermore, claim 1 recites "extracting a telephone number from the stored string of character information" (*see also* claims 5, 10, 11, 22 and 23). The Examiner acknowledges that Bayless fails to teach or suggest this recited feature (*see* Office Action, page 3). The Examiner alleges that Coad makes up for this acknowledged deficiency of Bayless (Coad: col. 3, lines 21-23; col. 7. lines 32-37; and Fig. 4). Applicant respectfully disagrees.

Like Bayless, Coad fails to teach or suggest "selecting a string of character information in a window displayed by the operating system, and storing the selected string of character information" (*see* claims 1, 5, 10, 11, 22 and 23). To the contrary, Coad describes embedding a text data portion into a text message to be transmitted from one cellular phone to another,

wherein the text data portion corresponds to a call-back telephone number (Coad: col. 2, lines 44-57). Thereafter, upon receipt of the text message, a text parser automatically processes the received text message character by character to detect predetermined delimiters (Coad: col. 7, lines 32-37). Then, the text parser separates a call-back telephone number using the predetermined delimiters and stores the extracted call-back telephone number in memory (*Id.*).

Thus, in Coad, a call-back telephone number is manually entered during entry of a text message to be sent to a second cellular phone (Coad: Fig. 3, steps 202, 204 and 208). Additionally, upon receipt of the text message, a text parser of the second cellular phone automatically processes the text message and extracts the embedded call-back telephone number using the predetermined delimiters (Coad: Fig. 6A, steps 258, 260, 266, 270 and 272).

The manual entry of the call-back telephone number at a transmitting end and the automatic extraction of the call-back telephone number at a receiving end does not correspond to "selecting a string of character information in a window displayed by the operating system, and storing the selected string of character information" (*see* claims 1, 5, 10, 11, 22 and 23). Consequently, Coad fails to teach and cannot possibly suggest "extracting a telephone number from the stored string of character information", as recited in claim 1 (*see also* claims 5, 10, 11, 22 and 23).

Additionally, in acknowledging that Bayless fails to teach or suggest "extracting a telephone number from the stored string of character information", the Examiner alleges that "one of ordinary skill in the art would have been motivated to seek an embodiment in order to

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/238,502
Attorney Docket No. Q52863

provide an actual working system as taught by Bayless et al.", which would have allegedly led one skilled in the art to combine the teachings of Coad with Bayless (*see* Office Action, page 3).

The Examiner appears to be implying that Bayless would not function without the capability of "extracting a telephone number from the stored string of character information", as recited in Applicant's claim 1 (*see also* claims 5, 10, 11, 22 and 23). Applicant respectfully disagrees and submits that the Examiner fails to establish a *prima facie* case of obviousness by demonstrating some reasonable suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, absent impermissible hindsight.

As the Federal Circuit has indicated, the USPTO is held to a *rigorous* standard when trying to show that an invention would have been obvious in view of the combination of two or more references. *See, In re Sang Su Lee*, 2002 U.S. App. LEXIS 855, *10 (Fed. Cir. 2002), *citing, e.g., In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). The Federal Circuit goes on to emphasize that the "need for specificity pervades this authority." *In re Sang Su Lee* at *10-*11 (emphasis added) (*citing In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"))).

Applicant respectfully submits that the current grounds of rejection do not satisfy the Federal Circuit's standard for demonstrating that the claimed invention would have been obvious in view of the combination of Bayless in view of Coad.

Bayless describes a telecommunication system that provides for telephone functions to be accessed through a client computer system, and wherein a server computer system provides telephony services, database services, and access to e-mail, voice mail, video conferencing, and facsimile systems (Bayless: Abstract). Conversely, Coad describes embedding call-back telephone numbers in text messages sent between cellular phones (Coad: Abstract). Given the disparate nature of these teachings, the Examiner's allegation that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include within Bayless the steps and means to extract a telephone number from a stored string of character information evidences impermissible hindsight on the part of the Examiner.

Specifically, Bayless does not involve text messaging. Thus, embedding call-back telephone numbers in text messages to be subsequently extracted therefrom, as described in Coad, would not be an obvious modification to the client/server system described in Bayless.

Bayless describes the use of directories to store telephone numbers, wherein entry and updating of the telephone numbers occurs manually (Bayless: col. 22, lines 35-42). Consequently, as acknowledged by the Examiner, Bayless does not teach or suggest "extracting a telephone number from the stored string of character information" (*see* Office Action, page 3). Indeed, by using directories (and other forms of manually entered data), Bayless does not need to

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/238,502
Attorney Docket No. Q52863

select a string of character information in a window displayed by an operating system, store the selected string of character information, or extract a telephone number from the stored string of character information.

Thus, since Bayless does not involve selecting a string of character information in a window displayed by an operating system and storing the selected string of character information, one skilled in the art would not have been motivated to implement the text parser of Coad in Bayless. Indeed, the text parser of Coad processes received text messages with call-back telephone numbers embedded therein using delimiters. Bayless does not involve any processing of received text messages, let alone text messages having call-back telephone numbers embedded therein.

Consequently, the Examiner has provided no reasonable suggestion or motivation, absent impermissible hindsight, to combine the teachings of Bayless and Coad.

For at least the above reasons, claim 1 (*see also* claims 5, 10, 11, 22, and 23) is not rendered obvious by a reasonable combination, if any, of Bayless and Coad.

B. Claims 2-4, 6-9, and 12-21

Claims 2-4, 6-9, and 12-21 are patentable over Bayless in view of Coad at least by virtue of their dependency.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/238,502
Attorney Docket No. Q52863

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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